



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,325	06/01/2006	Dieter Hagist	502901-348PUS	3578
27799 7590 09/24/2009 COHEN, PONTANI, LIEBERMAN & PAVANE LLP 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176				
EXAMINER BAYOU, AMENE SETEGNE				
ART UNIT 3746		PAPER NUMBER		
MAIL DATE 09/24/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/581,325

**Applicant(s)**

HAGIST ET AL.

**Examiner**

AMENE S. BAYOU

**Art Unit**

3746

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
- Paper No(s)/Mail Date 09/02/09
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/02/09 has been entered.

### ***Specification***

2. The abstract of the disclosure is objected to because it contains the word "means". Applicant is reminded of the proper language and format for an abstract of the disclosure. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. Correction is required. See MPEP § 608.01(b).

### ***Claim Objections***

3. Claim 14 is objected to because of the following informalities: Claim 14 is an exact duplicate of claim 6. Applicant is advised that should claim 6 be found allowable, claim 14 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. In re claim 7 it recites "supporting element situated opposite the pipe length at a designated distance" which is indefinite.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1,3-8, 11-16, 18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Firtion et al (International publication WO 02/40302 which is functionally equivalent to US patent 7252075).

**In Reference to Claim 1**

Firtion et al disclose a device for retaining a fuel pump in a fuel container of a motor vehicle (see figure 2 and 3) , with a **pump holder (30)** , with **first retaining means (42,43,44)** of the pump holder, provided for supporting on a baffle pot , and with **second retaining means (57 integral with 31)** of the pump holder, provided for supporting the

**fuel pump (15)** , and with a **damping device (34,35 )** connecting the first and second retaining means to one another, the retaining means being manufactured from plastic the first retaining means, the second retaining means and the damping device being manufactured as a single piece **(column 3, lines 15-16)** , in that the damping device has arms which are angled away from each other **(clearly shown in figure 3A)** , and in that during a movement of the fuel pump the arms are subject to at least a torsional or a bending load (inherently), wherein the arms of the damping device include at least one first vertical arm **(33,34 ,35)** extending substantially in a vertical direction and first and second horizontal arms **(both 34 and 35 have horizontal arms)** and extending substantially horizontally and angled away from the first vertical arm, the first and second horizontal arms being spaced apart in the vertical direction **(clearly shown in figure 3A)** and at least one of the first and the second horizontal arms is designed as an annular element **(34 ,35 in combination with ring 32 form annular element)** wherein a second vertical arm **(31 can be considered as another vertical arm )** connects the first horizontal arm and the second horizontal arm of the damping device, and wherein only the second horizontal arm of the arms **(34 or 35)** of the damping device is directly connected to the **second retaining means (57 integral with 31)**.

**In Reference to Claim 3**

Firtion et al disclose the device as claimed in claim 1 (see the rejection of claim 1 above), wherein the **first retaining means (42,43,44)** are designed such that they are supported radially on the inside of the baffle pot **(via slot 45)** and such that they rest axially, **in figure 3A**.

**In Reference to Claim 4**

Firtion et al disclose the device as claimed in claim 1 (see the rejection of claim 1 above), wherein the **second retaining means (57 integral with 31)** have a pipe length surrounding the fuel pump is an annular pipe that surrounds the fuel pump **(31 surrounds the fuel pump 15)**, in figure 3A.

**In Reference to Claim 5**

Firtion et al disclose the device as claimed in claim 4 (see the rejection of claim 4 above), wherein the **second retaining means (57 integral with 31)** have latching hooks **(44 is a hook and horizontal portion 57 can be considered as latching hook)**, arranged on the pipe length, for retaining the fuel pump, in figure 3A.

**In Reference to Claim 6, 14 and 15**

Firtion et al disclose the device as claimed in claim 1 (see the rejection of claim 1 above), wherein the first vertical arm **(34 or 35)** has a radially inwardly pointing hook **(44)**, and in that the hook limits the vertical movement of the **second retaining means (57)**.

**In Reference to Claim 7**

Firtion et al disclose the device as claimed in claim 4 (see the rejection of claim 4 above), wherein an **annular element (32)** connected to the first retaining means has a radially inwardly pointing supporting element **(hook 44)** situated opposite the pipe length.

**In Reference to Claim 8, 16 and 18**

Firtion et al disclose the device as claimed in claim 1 (see the rejection of claim 1

above), wherein the single-piece component comprising first and second retaining means and the damping device is manufactured from plastic by injection molding (**column 3, lines 15-16**) . Additionally In accordance to MPEP 2113, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. Please note that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product, i.e. the single piece component, does not depend on its method of production, i.e. injection molding. *In re Thorpe*, 227 USPQ 964, 966 (*Federal Circuit 1985*).)

**In Reference to Claim 11**

Firtion et al disclose the device as claimed in claim 1 (see the rejection of claim 1 above), wherein the first retaining means are designed such that they are supported radially on the inside of the baffle pot (**via 44**) and such that they rest axially, in figure 3A.

**In Reference to Claim 12 and 13**

Firtion et al disclose the device as claimed in claim 1 (see the rejection of claim 1 above), wherein the **second retaining means (57 integral with 31)** have a pipe length surrounding the fuel pump (**31 surrounds fuel pump 15**), figure 3A.

**In Reference to Claim 20**

Firtion et al disclose the device as claimed in claim 1 (see the rejection of claim 1 above), wherein only the **first horizontal arm (42)** of the first and second horizontal

arms is connected directly to the at least one of the **first vertical arm (43)** and wherein only the at least one **vertical arm (43)** of the arms is directly connected to the **first retaining means (44)**, in figure 3A.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 3, 4, 6-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,694,857 to Harris (Harris).

#### **In Reference to Claim 1**

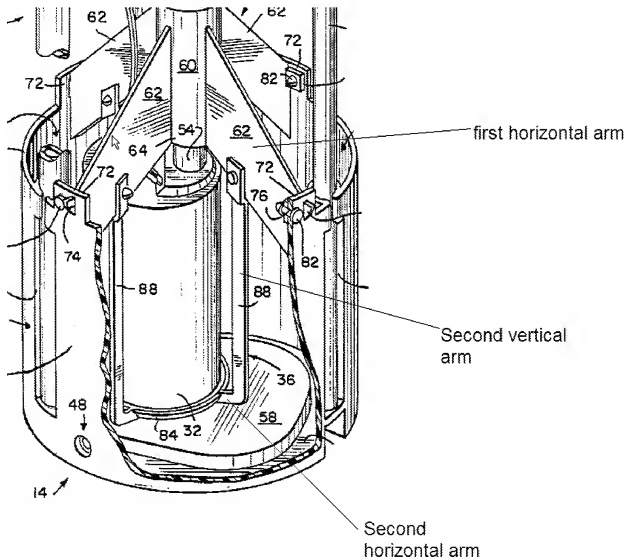
Harris teaches a device for retaining a fuel pump in a fuel container of a motor vehicle (see figure 1), with a pump holder (including fin members (62) and legs (88)), with first retaining means of the pump holder (the fins (62)), provided for supporting on a baffle pot (the fins are supported on a reservoir cup (30)), and with second retaining means of the pump holder (pump carrier dish(84)), provided for supporting the fuel pump, and with a damping device (the legs (88)) connecting the first and the second retaining means to one another, in that the damping device has arms which are angled away from each other (the legs (88) have a vertical portion and a horizontal portion that is arranged at 90° to the vertical portion. In addition item 62 which is attached to the



horizontal portion of vertical legs 88 can be considered as a horizontal arm), and in that during a movement of the fuel pump the arms are subject to at least a torsional or a bending load (the arms would be subject to any stresses applied to the fuel pump and fuel tank, which includes bending and torsional loads), wherein the arms of the damping device include at least one first vertical arm extending substantially in a vertical direction and first and second horizontal arms extending substantially horizontally and angled away from the first vertical arm (the legs (88) have a vertical portion and a horizontal portion that is arranged at 90° to the vertical portion), the first and second horizontal arms being spaced apart in the vertical direction, and at least one of the first and the second horizontal arms is designed as an annular element (the vertical arms are arranged annularly around the fuel pump), wherein a second vertical arm (one of the vertical arms 88 can be considered second vertical arm) connects the first horizontal arm and the second horizontal arm of the damping device (see annotated drawing), and wherein only the second horizontal arm of the arms of the damping device is directly connected to the second retaining means (see annotated drawing again).

Harris fails to teach that the retaining means is manufactured from plastic, or that the first retaining means, the second retaining means and the damping device are manufactured as a single piece. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the two retaining means and the dampener of Harris from a single piece of material, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. Additionally, it would have been

obvious to one of ordinary skill in the art at the time of invention to form the apparatus out of plastic, which is disclosed by Harris as an acceptable material for vehicle fuel tanks (see column 1 lines 13-34), since plastic is light weight and durable, and will not rust like metal.



**In Reference to Claim 3**

Harris teaches the device as claimed in claim 1 (see the rejection of claim 1 above), wherein the first retaining means (the fins (62)) are designed such that they are supported radially on the inside of the baffle pot (the fins are attached to the cup (30) via ears (72) that are received in a lug-receiving slot (74)) and such that they rest axially.

**In Reference to Claim 4**

Harris teaches the device as claimed in claim 1 (see the rejection of claim 1 above), wherein the second retaining means have a pipe length surrounding the fuel pump (The fuel pump (32) is contained in an annular pipe section which is attached to the pump carrier dish (84)).

**In Reference to Claim 6 and 14**

Harris teaches the device as claimed in claim 1 (see the rejection of claim 1 above), wherein the first vertical arm has a radially inwardly pointing hook (the vertical arms have associated horizontal arms), and in that the hook limits the vertical movement of the second retaining means (the horizontal arms serve to limit the axial movement of the pump carrier dish).

**In Reference to Claim 7**

Harris teaches the device as claimed in claim 4 (see the rejection of claim 4 above), wherein an annular element connected to the first retaining means has a radially inwardly pointing supporting element situated opposite the pipe length at a designated distance (the annular reservoir cup (30) has inwardly pointing snap-pins (82) which are situated at the opposite end of the assembly from the base of pump's outer pipe).

**In Reference to Claim 8, 16, 18**

Harris teaches the device as claimed in claim 1 (see the rejection of claim 1 above), but fails to teach that the component is manufactured by injection molding. In accordance to MPEP 2113, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. Please note that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product, i.e. the single piece component, does not depend on its method of production, i.e. injection molding. ***In re Thorpe, 227 USPQ 964, 966 (Federal Circuit 1985).***

**In Reference to Claim 9**

Harris teaches the device as claimed in claim 1 (see the rejection of claim 1 above), wherein the fuel pump has an annular, elastomeric sealing element (annular insulating gasket (86)) for the annular sealing of an opening (pump inlet (52), see figure 2) arranged in the bottom region of the baffle pot.

**In Reference to Claim 10**

Harris teaches the device as claimed in claim 9 (see the rejection of claim 9 above), wherein the sealing element has an obliquely angled sealing lip (the sealing element rests on the pump carrier dish (84) which has an obliquely angled rim, which causes the edge of the sealing element to be deformed at the same oblique angle when the two are coupled together), and in that the free end of the sealing lip rests on the bottom of the

baffle pot (the non-angled part of the sealing element rests on a filter (58) that rests on the bottom of the reservoir cup (30)).

**In Reference to Claim 11**

Harris teaches the device as claimed in claim 1 (see the rejection of claim 1 above), wherein the first retaining means (the fins (62)) are designed such that they are supported radially on the inside of the baffle pot (the fins are attached to the cup (30) via ears (72) that are received in a lug-receiving slot (74)) and such that they rest axially. In

**Reference to Claim 12**

Harris teaches the device as claimed in claim 1 (see the rejection of claim 1 above), wherein the second retaining means have a pipe length surrounding the fuel pump (The fuel pump (32) is contained in an annular pipe section which is attached to the pump carrier dish (84)).

**In Reference to Claim 13**

Harris teaches the device as claimed in claim 3 (see the rejection of claim 3 above), wherein the second retaining means have a pipe length surrounding the fuel pump (The fuel pump (32) is contained in an annular pipe section which is attached to the pump carrier dish (84)).

**In Reference to Claim 15**

Harris teaches the device as claimed in claim 3 (see the rejection of claim 3 above), wherein the first vertical arm has a radially inwardly pointing hook (the vertical arms have associated horizontal arms), and in that the hook limits the vertical movement of

the second retaining means (the horizontal arms serve to limit the axial movement of the pump carrier dish).

**In Reference to Claim 17**

Harris teaches the device as claimed in claim 1 (see the rejection of claim 1 above), wherein the fuel pump has an annular, elastomeric sealing element (annular insulating gasket (86)) for the annular sealing of an opening (pump inlet (52), see figure 2) arranged in the bottom region of the baffle pot.

**In Reference to Claim 19**

Harris teaches the device as claimed in claim 3 (see the rejection of claim 3 above), wherein the fuel pump has an annular, elastomeric sealing element (annular insulating gasket (86)) for the annular sealing of an opening (pump inlet (52), see figure 2) arranged in the bottom region of the baffle pot.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harris as applied to claim 1 in view of German Patent 19,534,411 to Frank.

**In Reference to Claim 5**

Harris teaches the device as claimed in claim 1 except the following limitation which is taught by Frank:

The second retaining means have latching hooks, arranged on the pipe length, for retaining the fuel pump (see figure 7 where the receptacle (14) is formed with a detent (36) which latches onto the top of the pump (14) to hold it in place). It would have been obvious to one skilled in the art at the time the invention was made to modify the pump of Harris by including latches to the retainer as taught by Frank for ease of installation.

12. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harris as applied to claim 1 in view of Fedelem et al. (US 4790185).

**In Reference to Claim 20**

Harris teaches the device as claimed in claim 1 except the following limitation which is taught by Fedelem et al.:

Only the first horizontal arm (40) of the first and second horizontal arms (40 and 36) is connected directly to the at least one of the first vertical arm (38) and wherein only the at least one vertical arm (38) of the arms is directly connected to the first retaining means (40 or 48), in figure 1. It would have been obvious to one skilled in the art at the time the invention was made to support only one of the horizontal arms on the vertical arm as taught by Fedelem et al to avoid redundancy (because it is possible to design the vertical support in such a way that only one vertical support will be able to transmit and carry the load).

***Response to Arguments***

13. Applicant's arguments with respect to the rejection of claims 1-20 over Frank have been considered and found persuasive. Therefore the rejection is withdrawn. However applicant's argument with respect to the rejection of claim 1-20 over Harris (see page 4 paragraphs 2 and 3) is not found persuasive. Applicant argued that the legs 88 of Harris are disposed in the same horizontal plane and are not spaced apart in the vertical direction. Examiner notes that there is some confusion by the applicant in labeling the vertical legs and the horizontal portion of the legs (i.e. the arms) as being the same (see annotated drawing above for clarification). As clearly be seen in the drawing the

horizontal arms of the vertical legs 88 are spaced apart in vertical direction and are not located on the same horizontal plane.

***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amene Bayou whose telephone number is (571)270-3214. The examiner can normally be reached on Monday through Friday, 8:30am to 5:30pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Devon Kramer can be reached on 571-272-7118. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Devon C Kramer/  
Supervisory Patent Examiner, Art  
Unit 3746